REMARKS

I. Status of the Claims

Claims 1-3, 6, 28, 40, 47, 72, 75, 80, 96-98, 101, 123, 135, 142, 167, 170, 175, and 191-206 are now pending in this application. Claims 1, 96, 195, and 203 have been amended herein without prejudice or disclaimer. Applicants expressly reserve the right to pursue any subject matter canceled herein in a continuation application.

II. Amendments to the Claims

Applicants have amended independent claims 1 and 195 to recite, *inter alia*, a method for increasing the intensity of color in a composition comprising at least one heteropolymer and at least one coloring agent, wherein the at least one heteropolymer is included in the composition in an amount effective to increase the intensity of the at least one coloring agent. Applicants have amended independent claims 96 and 203 to recite, *inter alia*, a method of providing intense color to a composition comprising at least one heterpolymer and at least one coloring agent, wherein the at least one heteropolymer is included in the composition in an amount effective to provide intense color. Support for the amendments is found in the original specification of this application in at least paragraphs [0005] and [0067], and the Example found at paragraphs [00126] - [00129]. As such, no new matter is added by the amendments and Applicants respectfully request that they be entered without objection.

III. Amendment to the Specification

Applicants have amended the title of this application to better reflect the subject matter recited in the currently pending claims. Applicants submit that the amendment does not add any new matter as discussed above in Section II with respect to the amendments to the claims, and therefore respectfully request that it be entered without objection.

IV. The Office's Claim Construction

On pages 3 and 4 of the Office Action, in sections entitled "Claim Construction," the Office asserts that lipsticks with a dispersed coloring agent also *per se* have a high gloss. The amended claims of this application do not recite gloss, thus mooting the applicability of the Office's assertion. However, merely to clarify the record, Applicants respectfully note their disagreement with the Office's position and believe that the Office incorrectly assumes a relationship between gloss and the dispersion of a coloring agent.

For instance, paragraph [0002] of the present application states that dispersion of a coloring agent "can" result in higher gloss, not that higher gloss necessarily results from dispersion. As such, Applicants respectfully disagree with the Office's position regarding any *per se* relationship between gloss and a dispersed coloring agent.

IV. Rejections Under 35 U.S.C. §§ 102(e)

A. U.S. Patent No. 6,423,324

Claims 1-3, 6, 40, 47, 96-98, 101, 135, and 142 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,423,324 to Murphy et al. ("the '324

patent"). According to the Office, the '324 patent teaches a lipstick composition comprising a polyamide resin, a fatty phase, gloss, and intense color. *See* Office Action at 3. The Office has taken the position that intense color is inherently taught by the '324 patent "since all the lipsticks have intense color based upon the [coloring agent] or pigment used." *Id.* Applicants respectfully traverse this rejection.

In order to show anticipation, the Office must show that a single reference discloses, either expressly or inherently, each and every element of the pending claims. *See* MPEP § 2131. Furthermore, "to establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. . . . The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (citations and quotations omitted) (emphasis added); *see also* MPEP § 2112(IV) ("The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.") (emphasis in original). In other words, the burden is on the Office to show that the result or characteristic would necessarily be present in order for a rejection based on inherency to be proper. With these standards in mind, Applicants submit that the '324 patent does not anticipate the claims as presented herein for at least the following reasons.

Specifically, Applicants submit that the '324 patent does not teach either increasing the intensity of color or providing intense color to a composition, as recited in the present claims. The Office has not pointed to any express teaching in the '324 patent of either increasing the intensity of color or providing intense color to a

composition, and in fact appears to concede that no such express teaching exists in view of the reliance on the theory of inherency to support its position of anticipation. However, the Office has not offered any evidence, either in the '324 patent or elsewhere, to show that (1) intense color would necessarily be present in the compositions of the '324 patent, or (2) the skilled artisan would necessarily understand such intense color to be present in the compositions of that reference, as required by *Robertson*, *supra*.

Rather, not only do the teachings of the '324 patent not provide the required understanding of intense color to the skilled artisan, but in fact, the teachings would lead the skilled artisan away from such an understanding in light of the fact that the reference is directed to "transparent or translucent" compositions. *See* '324 abstract. The reference explains that "[a] lipstick containing a polyamide resin can be made optically clear (i.e., translucent or transparent) through a proper selection of suitable solvents" (col. 1, lines 25-27), and notes that "it would be desirable to provide an optically clear polyamide resin-based composition that is not irreparably damaged by the effects of syneresis" (col. 1, line 66 to col. 2, line 1). In keeping with the focus of its teachings, each of the exemplary lipglosses in the '324 patent relied on by the Office in support of its inherency position is transparent or translucent. Even the reference's disclosure of adding color components to its composition warns against changing the composition "from transparent to translucent or even opaque" and instructs the skilled artisan to add only very small amounts of color components—a maximum of two percent. Col. 11, lines 30-38. In fact, Applicants assert that the skilled artisan would understand that the '324 patent teaches the addition of color components only as a means to counteract the

"slight yellow tinge [of the composition] in the absence of color agents" (col. 11, line 29) and achieve the desired transparent or translucent effect.

The optically clear compositions desired and taught by the '324 patent are clearly at odds with either increasing the intensity of color or providing intense color to a composition, since the resulting color intensity would interrupt or diminish the desired transparent or translucent effect. The reference itself teaches against adding an amount of color component over two percent and cautions against any use of color agents that would opacify the described compositions. *See* col. 11, lines 30-38. That disclosure, in combination with the general teachings of optically clear compositions, reveals that the skilled artisan would not necessarily understand an increase in the intensity of color or the providing of intense color to be disclosed or present in the '324 compositions. In fact, the skilled artisan would not expect any color intensity at all, as that would interfere with the optical clarity desired by the reference's compositions. Therefore, Applicants submit that the '324 patent does not inherently teach either increasing the intensity of color or providing intense color to a composition, as recited in the pending and amended claims of this application.

Because the '324 patent neither expressly or inherently teaches either increasing the intensity of color or providing intense color to a composition, the reference cannot anticipate the pending claims of this application, as amended herein. Therefore, Applicants respectfully request that the Office withdraw this rejection.

B. U.S. Patent No. 6,402,408

Claims 1-3, 6, 28, 40, 47, 96-98, 101, 123, 135, 142, 191-196, and 198-206 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,402,408 to

Ferrari ("the '408 patent"). According to the Office, the '408 patent teaches a composition comprising Uniclear 80 or 100, a coloring agent, and a fatty phase. *See* Office Action at 3. Applicants respectfully traverse this rejection.

Applicants submit that the '408 patent does not teach either increasing the intensity of color or providing intense color to a composition, as recited in the pending claims of this application, and note that the Office has not pointed to any express or inherent teaching of intense color or methods of providing intense color in the '408 patent. Like the '324 patent discussed above, the Office has not offered any evidence, either in the '408 patent or elsewhere, to show that (1) intense color would necessarily be present in the compositions of the '408 patent, or (2) the skilled artisan would necessarily understand such intense color to be present in the compositions of that reference, as required by *Robertson*, *supra*. The '408 patent states only that its compositions, when colored, "may, after they have been applied to a keratinous material, give a glossy deposit of *uniform* color." Col. 6, lines 6-8 (emphasis added). The skilled artisan would not necessarily interpret that statement regarding *uniform* color as teaching intense color, as presently recited in the claims of this application, would necessarily be present in its compositions. Further, the '408 patent does not recognize or discuss any color intensity at all in its inventive compositions. Therefore, the '408 patent does not inherently teach increasing the intensity of color or providing intense color to a composition, as recited in the pending and amended claims of this application.

In addition, the claims recite that at least one heteropolymer is included in an "amount effective" either to increase the intensity of color or to provide said intense

color. The Federal Circuit has ruled that a reference cannot inherently anticipate when the reference's teachings are ambiguous with respect to the claimed element and where the reference may not produce a "sufficient amount" needed to meet the claimed element. *Mentor H/S, Inc. v. Med. Device Alliance, Inc.*, 244 F.3d 1365, 1376 (Fed. Cir. 2001) (finding a process claim reciting the use of heat to melt fat not to be inherently anticipated by a reference that taught generating heat because "the testimony is inconclusive as to whether or not a sufficient amount of heat is generated to melt fat"). Similar to *Mentor*, the claims recite the inclusion of the at least one heteropolymer in an "amount effective" to produce the claimed color intensity, while the '408 patent is at best ambiguous as to its teachings of color intensity and certainly may not include the recited "amount effective" to achieve the claimed color intensity. As is well-known in the chemical arts, the inclusion of too much or too little of a substance may radically affect the ability of a substance to function as intended. For that reason, in particular, "[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." MPEP § 2112(IV) (quoting *Ex Parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (B.P.A.I. 1990)). Because the Office cannot provide any basis in fact or credible technical reasoning showing that the claimed invention is necessarily present in any of the cited references, including the '408 patent, Applicants submit that the rejection cannot stand.

Because the '408 patent neither expressly or inherently teaches either increasing the intensity of color or providing intense color to a composition, the reference cannot

anticipate the pending claims of this application, as amended herein. Therefore, Applicants respectfully request that the Office withdraw this rejection.

V. Rejection under 35 U.S.C. § 103(a)

The Office has rejected all of the pending claims under 35 U.S.C. § 103(a) as obvious over the combination of U.S. Patent No. 5,783,657 to Pavlin ("the '657 patent"), the '324 patent, the '408 patent, and U.S. Patent No. 6,726,917 to Kanji et al. ("the '917 patent"). The Office asserts that the '657 patent teaches polyamide polymers of formula (I) for use in cosmetics, that the '324 patent teaches the use of polyamide resins with fatty alcohols, that the '324 patent teaches a method of dispersing a coloring agent in a composition, and that the '917 patent teaches polysaccharide resins and film-forming polymers. *See* Office Action at 4-5. Applicants respectfully traverse this rejection.

First, Applicants submit that the '917 patent is not properly citable as part of an obviousness rejection by operation of 35 U.S.C. § 103(c)(1). In the Reply to Office Action filed March 22, 2005, Applicants explained that the '917 patent (1) qualifies as subject matter developed by another person than the present application, (2) is prior art only under 35 U.S.C. § 102(e), and (3) was subject to an assignment to the assignee of this application at the time this invention was made. *See* pages 32-33. As a result, 35 U.S.C. § 103(c)(1) operates to bar the '917 patent from being used as part of an obviousness rejection. *See* MPEP § 2146. Applicants, therefore, have omitted the '917 patent from their arguments and respectfully request that the Office withdraw any reliance upon the '917 patent in any rejection under 35 U.S.C. § 103(a).

Applicants submit that the combination of the remaining cited references can not support a *prima facie* case of obviousness. As the Office is aware, "to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant." *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000). Further, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *See* MPEP § 2143.01. Finally, the skilled artisan must have had some reasonable expectation of success in making the proposed combination to achieve the claimed invention. *See* MPEP § 2143.02; *see also In re Royka*, 490 F.2d 981, 985 (C.C.P.A. 1974) (finding a lack of obviousness where the cited references did not disclose the "essence of appellants' invention" set forth in the claims).

Applicants submit that the combination of the '657, '324, and '408 patents does not create a *prima facie* case of obviousness of the presently claimed invention. As amended herein, each of the independent claims recites, *inter alia*, a method for increasing the intensity of at least one coloring agent in a composition or a method for providing intense color to a composition. As Applicants have already discussed above, neither the '324 patent nor the '408 patent teaches or suggests those claim elements, either expressly or inherently. Applicants also submit that the '657 patent does not teach or suggest any increase in the intensity of at least one coloring agent, or providing intense color to a composition, and the Office has not pointed to any such disclosure or any suggestion of that disclosure that would have been recognized by the skilled

artisan. Because none of the cited references teach or suggest those methods, which are recited in each of the independent claims as amended herein, the references when combined do not teach or suggest the "essence of Applicants' invention," and thus do not establish a *prima facie* case of obviousness. *See In re Royka, supra.*

From that lack of any teaching or suggestion, the skilled artisan would not have been motivated to combine the references or modify their disclosures in an effort to achieve the claimed inventions, since nothing in the references suggests the desirability of, or reasonable expectation of success in, making such a combination or modification. Accordingly, the Office has not established a *prima facie* case of obviousness of the presently claimed invention based on the combination of the '657, '324, and '408 patents. As such, Applicants respectfully request that this rejection be withdrawn.

VI. Commonly Assigned Co-Pending Applications and Patents

In the Previous Response dated March 22, 2005, Applicants noted in Table A information regarding co-pending applications and patents, including the present application, and submitted copies of the pending claims as of the date of that submission for every case identified. In the following continuation of Table A, Applicants have noted two additional applications and updated the issuance, publication, and/or assignment information for certain previously-identified cases. Furthermore, Applicants also submit herewith, as Exhibit 1, copies of the currently pending claims from the two newly identified cases as well as the following cases whose claims have been amended or have issued since March 22, 2005: 09/618,066; 09/733,896; 09/733,898; 09/749,036; 09/937,314; 10/012,051; 10/046,568; 10/047,987;

10/182,830; 10/203,018; 10/203,254; 10/203,374; 10/203,375; 10/312,083; 10/413,217; 10/746,612; 10/747,412; 10/787,440; and 11/212,811. Applicants submit those claims for the Office's convenience in evaluating any potential issues regarding statutory or obviousness-type double patenting.

Applicants also direct the Office's attention to U.S. Patent No. 6,761,881 B2, which issued to Isabelle Bara on July 13, 2004, and is assigned to L'Oréal. That patent is also related to the patents and co-pending applications identified in Table A above. A copy of the issued claims of that patent is also attached as part of Exhibit 1.

Table A (*continued*) — Co-Pending Applications and Patents

Attorney Docket No.	U.S. Patent Application No.	U.S. Filing Date or § 371(c) Date	Inventor(s)	Title	Assignment Recorded (Reel, Frame, Date)	Publication Date
05725.0656-00000	09/618,066 Issued on November 1, 2005, as U.S. Patent No. 6,960,339	July 17, 2000	Véronique FERRARI and Pascal SIMON	COMPOSITIONS IN RIGID FORM STRUCTURED WITH A POLYMER	Reel 011057, Frame 0676, on September 11, 2000	N/A: Will not publish
05725.0816-03000	11/212,811	August 29, 2005	Véronique FERRARI, Richard KOLOD-ZIEJ, Carlos O. PINZON, and Paul THAU	COMPOSITION COMPRISING A POLYAMIDE POLYMER AND AT LEAST ONE INERT FILLER	Reel 014055, Frame 0428, on March 24, 2003	Not Yet Published

Attorney Docket No.	U.S. Patent Application No.	U.S. Filing Date or § 371(c) Date	Inventor(s)	Title	Assignment Recorded (Reel, Frame, Date)	Publication, Date
05725. 0932-00000	09/937,314, issued on March 22, 2005, as U.S. Patent No. 6,869,594	September 24, 2001 § 371(c) Date: December 6, 2001	Véronique FERRARI	A TRANSFER-FREE MASCARA COMPOSITION COMPRISING AT LEAST ONE VOLATILE SOLVENT AND AT LEAST ONE POLYMER	Reel 012476, Frame 0507, on January 17, 2002	U.S. Published Application No. US 2004/ 0086478 A1, on May 6, 2004
05725. 0932-01000	10/993,431	November 22, 2004	Véronique FERRARI	A TRANSFER-FREE COMPOSITION STRUCTURED IN RIGID FORM BY A POLYMER	Reel 012476, Frame 0507, on January 17, 2002	U.S. Published Application No. US 2005/ 0089541 A1, on April 28, 2005
05725. 1003-00000	10/012,029, issued on December 28, 2004, as U.S. Patent No. 6,835,399	December 11, 2001	Nathalie COLLIN	COSMETIC COMPOSITION COMPRISING A POLYMER BLEND	Reel 013142, Frame 0645, on August 1, 2002	U.S. Published Application No. US 2003/ 0012764 A1, on January 16, 2003
05725. 1003-01000	10/993,430	November 22, 2004	Nathalie COLLIN	COSMETIC COMPOSITION COMPRISING A POLYMER BLEND	Reel 013142, Frame 0645, on August 1, 2002	U.S. Published Application No. US 2005/ 0089505 A1, on April 28, 2005
05725. 1004-00000	10/012,051, issued on April 19, 2005, as U.S. Patent No. 6,881,400	December 11, 2001	Nathalie COLLIN	USE OF AT LEAST ONE POLYAMIDE POLYMER IN A MASCARA FOR RAPIDLY INCREASING THE AMOUNT OF MAKE-UP DEPOSITED ON EYELASHES	Reel 012847, Frame 0285, on April 30, 2002	U.S. Published Application No. US 2002/ 0189030 A1, on December 19, 2002

Attorney Docket No.	U.S. Patent Application No.	U.S. Filing Date or § 371(c) Date	Inventor(s)	Title	Assignment Recorded (Reel, Frame, Date)	Publication Date
05725. 1004-01000	10/990,475	November 18, 2004	Nathalie COLLIN	USE OF A POLYMER FOR OBTAINING AN EXPRESS MAKE-UP OF KERATIN MATERIALS	Reel 012847, Frame 0285, on April 30, 2002	U.S. Published Application No. US 2005/ 0089491 A1, on April 28, 2005
05725. 1336-00000	10/459,636	June 12, 2003	Shao Xiang LU and Mohamed KANJI	COSMETIC EMULSIONS CONTAINING AT LEAST ONE HETERO POLYMER AND A SUNSCREEN AND METHODS OF USING SAME	Reel 014562, Frame 0576, dated October 3, 2003	U.S. Published Application No. 2004/ 0042980 A1, on March 4, 2004
05725. 1337-00000	10/618,315 ABANDONED	July 11, 2003	Shao Xiang LU, Terry VAN LIEW, and Nathalie GEFFROY-HYLAND	COSMETIC COMPOSITIONS COMPRISING A STRUCTURING AGENT, SILICONE POWDER AND SWELLING AGENT	Reel 014385, Frame 0277, dated August 14, 2003 Corrective assignment at Reel 015570, Frame 0838, dated January 14, 2005	U.S. Published Application No. US 2005-0008598 A1, on January 13, 2005

Attorney Docket No.	U.S. Patent Application No.	U.S. Filing Date or § 371(c) Date	Inventor(s)	Title	Assignment Recorded (Reel, Frame, Date)	Publication, Date
05725.1338-01000	10/746,612	December 22, 2003	Shao Xiang LU, Terry VAN LIEW, Nathalie GEFFROY-HYLAND, and Mohamed KANJI	COSMETIC COMPOSITIONS COMPRISING A STRUCTURING AGENT, SILICONE POWDER AND SWELLING AGENT	Reel 014385, Frame 0277, dated August 14, 2003 Corrective assignment at Reel 015570, Frame 0838, dated January 14, 2005 Reel 016228, Frame 0044, dated July 6, 2005	U.S. Published Application No. US 2005-0008599 A1, on January 13, 2005
05725.1338-02000	10/747,412	December 22, 2003	Shao Xiang LU and Mohamed KANJI	COSMETIC EMULSIONS CONTAINING AT LEAST ONE HETERO POLYMER AND AT LEAST ONE SUNSCREEN AND METHODS FOR USING THE SAME	Reel 016225, Frame 0391, on July 6, 2005	U.S. Published Application No. US 2004/0247549 A1, on December 9, 2004
05725.1378-00000	11/019,382	December 23, 2004	Wei YU and Véronique FERRARI	COSMETIC COMPOSITION COMPRISING TWO DIFFERENT HETERO POLYMERS AND METHOD OF USING SAME	Reel 016543, Frame 0749, on May 10, 2005	U.S. Published Application No. US 2005/0191327 A1, on September 1, 2005

Attorney Docket No.	U.S. Patent Application No.	U.S. Filing Date or § 371(c) Date	Inventor(s)	Title	Assignment Recorded (Reel, Frame, Date)	Publication Date
06028.0047-00000	10/494,864	May 7, 2004	Dider CANDAU and Christèle GOMBERT	COMPOSITION CONTAINING AN AMINO ACID N0ACYLATED ETER AND A POLYAMIDE STRUCTURED UV FILTER	Reel 016044, Frame 0874, on November 23, 2004	U.S. Published Application No. US 2005/0065251 A1, on March 24, 2005

VII. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application, and the timely allowance of the pending claims. Should the Office have any questions regarding this paper, or wish to discuss any of the amendments or arguments made herein, Applicants invite the Office to contact their undersigned representative at the telephone number listed below.

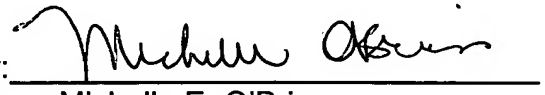
Applicants note that the Office Action contains numerous characterizations of the previously-claimed inventions and the cited references, which were not discussed above and with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any such statement or characterization in the previous Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: December 15, 2005

By: 

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Attachments: **Exhibit 1** (claim sets)